

ESTTA Tracking number: **ESTTA706604**

Filing date: **11/04/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Naked Brand Group, Inc.
Granted to Date of previous extension	11/04/2015
Address	311 S. Division Street Carson City, NV 89703 UNITED STATES
Attorney information	MICHAEL J LEONARD FOX ROTHSCHILD LLP 997 LENOX DRIVE, BLDG 3 LAWRENCEVILLE, NJ 08648-2311 UNITED STATES ipdocket@foxrothschild.com, mleonard@foxrothschild.com

Applicant Information

Application No	86063139	Publication date	07/07/2015
Opposition Filing Date	11/04/2015	Opposition Period Ends	11/04/2015
International Registration No.	NONE	International Registration Date	NONE
Applicant	Khamis, Badih 820 38th Avenue Lachine, Quebec, H8T2C3 CANADA		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Clothing, namely, Underwear, Bath Robes, Shirts, T-Shirts, Sweaters, Pants

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3669650	Application Date	10/23/1998
Registration Date	08/18/2009	Foreign Priority Date	NONE
Word Mark	NAKED		

Design Mark	NAKED
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/06/01 First Use In Commerce: 2009/05/09 [MEN'S CLOTHING, namely, CAPS;] T-SHIRTS, TOPS, [TANK TOPS, JACKETS, PANTS, TROUSERS, JEANS, SHORTS;] LOUNGEWEAR, [ROBES, BATHROBES,] PAJAMAS, BOXER SHORTS, UNDERGARMENTS, [SWIMWEAR, BATHING TRUNKS; WOMEN'S CLOTHING, NAMELY, CAPS; T-SHIRTS,] TANK TOPS, [CROP TOPS, BLOUSES, DRESSES, SKIRTS, PANTS, JEANS, COATS,] LINGERIE, BRAS, [UNDERGARMENTS, UNDERGARMENT THONGS, BUSTIERS, CORSETS,] CAMISOLES, CHEMISES, NIGHTGOWNS, PEIGNOIRSETS, TEDDIES, PAJAMAS, ROBES, BATHROBES, [SWIMWEAR, BATHING SUITS, BEACH THONGS]

U.S. Registration No.	3974743	Application Date	10/23/1998
Registration Date	06/07/2011	Foreign Priority Date	NONE
Word Mark	NAKED ATHLETICS		
Design Mark	NAKED ATHLETICS		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2010/01/15 Men's clothing, namely, caps; T-shirts,tank tops, jackets, jeans, shorts; boxer shorts, undergarments, swimwear, bathing trunks; women's clothing, namely, caps; T-shirts, tank tops, crop tops, dresses, shorts, skirts, jeans, lingerie, bras, undergarments, undergarment thongs, bustiers, corsets, camisoles, chemises, peignoir sets, teddies, robes, swimwear, bathing suits		

U.S. Registration No.	4392517	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE

Word Mark	NAKED ATTRACTION
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2012/02/16 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, corsets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jeans, robes, underwear, boxer briefs, and bathingsuits

U.S. Registration No.	4392513	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED BOUND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/02/09 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, bustiers, corsets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jeans, robes, underwear, boxer briefs, and bathing suits		


U.S. Registration No.	4392518	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED ECSTASY		

Design Mark	NAKED ECSTASY
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/04/15 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, cor-sets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jeans, robes, un-derwear, boxer briefs, and bathingsuits


U.S. Registration No.	4392520	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED EROTICA		
Design Mark	NAKED EROTICA		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/11/21 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, cor-sets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, ties, T-shirts, tank tops, jeans, robes, underwear, boxer briefs, and bathing suits		

U.S. Registration No.	4392519	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED FANTASY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2012/01/19 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, cor-sets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jackets, jeans, robes, underwear, boxer briefs, and bathing suits


U.S. Registration No.	4392516	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED INNOCENCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/08/10 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, cor-sets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis		


U.S. Registration No.	4392514	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED KISS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/07/12 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, cor-sets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jeans, robes, un-derwear, boxer briefs, and bathingsuits

U.S. Registration No.	4392521	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED LOVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/03/07 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, cor-sets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jeans, robes, un-derwear, boxer briefs, and bathingsuits		

U.S. Registration No.	4392515	Application Date	10/01/2009
Registration Date	08/27/2013	Foreign Priority Date	NONE
Word Mark	NAKED OBSESSION		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/01/06 First Use In Commerce: 2011/03/17 Women's clothing, namely, caps, T-shirts, tank tops, crop tops, dresses, skirts, pants, jeans, jackets, lingerie, bras, underwear, thongs, boy shorts, bustiers, corsets, camisoles, chemises, nightgowns, peignoirs, teddies, robes, bathing suits, and bikinis; men's clothing, namely, caps, T-shirts, tank tops, jeans, robes, underwear, boxer briefs, and bathingsuits

U.S. Registration No.	4822252	Application Date	03/23/2000
Registration Date	09/29/2015	Foreign Priority Date	NONE
Word Mark	PLANET NAKED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/06/06 First Use In Commerce: 2015/03/06 crop tops, bras, camisoles, bathing suits, tank tops, caps, bathing trunks, t-shirts, pants, shorts, skirts, robes, lingerie, dresses, corsets, bustier, chemises, sleepwear		

Attachments	75568492#TMSN.png(bytes) 75568493#TMSN.png(bytes) 77838986#TMSN.png(bytes) 77838931#TMSN.png(bytes) 77838995#TMSN.png(bytes) 77839015#TMSN.png(bytes) 77839007#TMSN.png(bytes) 77838973#TMSN.png(bytes) 77838950#TMSN.png(bytes) 77839041#TMSN.png(bytes) 77838962#TMSN.png(bytes) 76005983#TMSN.png(bytes) 2015-11-04 NAKED UNDERNEATH Opposition.pdf(132327 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/michael leonard/
Name	MICHAEL J LEONARD
Date	11/04/2015

RE: U.S. Trademark Application Serial No. 86/063139
Published in the Official Gazette on 7 July 2015

Applicant

Opposition No.

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 86/063139 filed 12 September 2013 by Badih Khamis (“Applicant”), to register the mark NAKED UNDERNEATH for goods described as “Clothing, namely, Underwear, Bath Robes, Shirts, T-Shirts, Sweaters, Pants” in International Class 025 (“Applicant’s Goods”), which was published in the Official Gazette on 7 July 2015, Naked Brand Group Inc. (“Opposer”) of Carson City, Nevada believes it will be damaged by the registration of the NAKED UNDERNEATH mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a Canadian citizen having an address at 820 38th Avenue, Lachine, Quebec H8T2C3 Canada.

2. On 12 September 2013, Applicant filed Application Serial No. 86/063139 for the mark NAKED UNDERNEATH for Applicant's Goods based on Applicant's intent to use the mark in the United States.

3. Opposer, Naked Brand Group Inc., is a Nevada corporation and the owner of the NAKED fashion brand.

4. Opposer is using, has invested substantial resources in advertising, promoting and selling its goods, and has acquired substantial goodwill and notoriety in its NAKED trademark.

5. Opposer is the owner of U.S. Registration No. 3,669,650 for the mark NAKED, currently covering goods described as “t-shirts, tops, loungewear, pajamas, boxer shorts, undergarments, tank tops, lingerie, bras, camisoles, chemises, nightgowns, peignoir sets, teddies, pajamas, robes, bathrobes,” in International Class 025 (collectively “Opposer’s Goods”). Opposer’s U.S. Registration No. 3,669,650 is incontestable and entitled to a constructive date of first use of 23 March 1998.

6. The foregoing Registration is not limited by channels of trade or classes of purchasers. Opposer's Registration is valid, subsisting and is *prima facie* evidence of the validity of the registered Mark set forth therein, and Opposer's exclusive right to use the registered Mark set forth therein in connection with the goods specified in the registration.

7. Opposer is also the owner, by assignment, of the following Registrations for NAKED formative marks covering goods in Class 25:

Trademark	App. No./Reg. No.	Status/Status Date
NAKED ATHLETICS	RN: 3974743 SN: 75568493	Registered June 7, 2011
NAKED ATTRACTION	RN: 4392517 SN: 77838986	Registered August 27, 2013
NAKED BOUND	RN: 4392513 SN: 77838931	Registered August 27, 2013
NAKED ECSTASY	RN: 4392518 SN: 77838995	Registered August 27, 2013
NAKED EROTICA	RN: 4392520 SN: 77839015	Registered August 27, 2013
NAKED FANTASY	RN: 4392519 SN: 77839007	Registered August 27, 2013
NAKED INNOCENCE	RN: 4392516 SN: 77838973	Registered August 27, 2013
NAKED KISS	RN: 4392514 SN: 77838950	Registered August 27, 2013
NAKED LOVE	RN: 4392521 SN: 77839041	Registered August 27, 2013
NAKED OBSESSION	RN: 4392515 SN: 77838962	Registered August 27, 2013
PLANET NAKED	RN: 4822252 SN: 76005983	Registered September 29, 2015

All of the foregoing registrations have filing dates preceding Applicant's alleged 12 September 2012 date of first use.

8. Opposer is also the owner, by assignment, of the following pending Applications for NAKED formative marks covering goods in Class 25:

Trademark	App. No./Reg. No.	Status/Status Date
BABY NAKED	SN: 77302916	Pending - Suspended March 25, 2014 Filed: October 12, 2007
NAKED BEACH	SN: 76005995	Allowed Filed: March 23, 2000
NAKED BEAUTY	SN: 76005990	Allowed Filed: March 23, 2000
NAKED BOYZ	SN: 76005988	Allowed Filed: March 23, 2000
NAKED DANCE	SN: 76011962	Allowed Filed: March 29, 2000
NAKED DESIRE	SN: 76005994	Allowed Filed: March 23, 2000
NAKED GIRL	SN: 76005989	Allowed Filed: March 23, 2000
NAKED SILHOUETTE	SN: 76005985	Allowed Filed: March 23, 2000

All of the foregoing applications have filing dates preceding Applicant's 12 September 2013 constructive date of first use.

9. Opposer will rely upon its ownership of its federal trademark registration for the mark NAKED, its rights to its various NAKED formative marks, and the common law rights it has obtained through its prior and continuous use of its NAKED Marks in commerce throughout the United States dating back to at least as early as June of 1998.

10. Commencing prior to Applicant's filing date, Opposer commenced its use of the NAKED Mark on various items of clothing, including those goods set forth in Registration No. 3,669,650.

11. Since its initial use of the NAKED Mark, Opposer has made a substantial investment in advertising, promoting and selling Opposer's Goods under its NAKED Mark.

Opposer has extensively used, advertised, promoted, offered, and sold Opposer's Goods to the public through various channels of trade in commerce, including the internet. Opposer's customers and the public in general know and recognize Opposer's NAKED Mark and associate same with Opposer and/or Opposer's Goods. Opposer has built extensive notoriety and goodwill in connection with the offering of goods under Opposer's NAKED Mark.

12. Applicant's filing of Application Serial No. 86/063139 for NAKED UNDERNEATH is without license, authorization or permission from Opposer.

**FIRST GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - FEDERAL)**

13. Opposer re-alleges the allegations contained in paragraphs 1 through 12 of this Notice of Opposition.

14. Applicant's NAKED UNDERNEATH Mark fully incorporates Opposer's NAKED Mark, and is likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

15. Applicant's filing date of 12 September 2013 is subsequent to the filing and registration dates of Opposer's NAKED Registration as set forth above, as well as the filing dates of Opposer's NAKED formative marks set forth above in Paragraphs 7 & 8.

16. Opposer's and Applicant's Goods are identical and/or closely related and are offered or are likely to be offered through the same channels of trade and purchased and used by the same class of purchasers. Applicant's Goods are not limited and are thus presumed to travel in the same channels of trade, including those utilized for Opposer's Goods, to the same class(es) of consumers. The inclusion of the generic UNDERNEATH term in conjunction with

the NAKED term to form Applicant's mark is insufficient to avoid confusion, mistake or wrongful association between the respective parties' goods, especially given the fact that Opposer's primary product offerings consist of underwear and t-shirts.

17. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Goods sold, offered for sale, and marketed under Applicant's NAKED UNDERNEATH Mark and misled into believing that such Goods are produced, distributed, offered, sold, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

18. Opposer will be damaged by Applicant's registration of the NAKED UNDERNEATH Mark as set forth in Application Serial No. 86/063139, in that Applicant's NAKED UNDERNEATH Mark is confusingly similar to Opposer's NAKED Mark and is intended to be used in connection with Goods identical to, similar to, and/or closely related to Opposer's Goods.

19. Applicant's registration of the NAKED UNDERNEATH Mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its NAKED Mark.

**SECOND GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - COMMON LAW)**

20. Opposer re-alleges the allegations contained in paragraphs 1 through 19 of this Notice of Opposition.

21. Opposer uses the NAKED Mark to identify Opposer's Goods, specifically its clothing products.

22. Applicant's NAKED UNDERNEATH Mark fully incorporates Opposer's NAKED Mark and is likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

23 Applicant's 12 September 2012 constructive date of first use as set forth in Application Serial No. 86/063139 is subsequent to Opposer's date of first use of its NAKED Mark.

24. Opposer's Goods and Applicant's Goods are identical and/or closely related, and are offered or are likely to be offered through the same channels of trade and purchased by the same class of purchasers.

25. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods sold and marketed under Applicant's NAKED UNDERNEATH Mark and misled into believing that such goods are produced by, offered by, sold by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

26. Opposer will be damaged by the registration of the NAKED UNDERNEATH Mark as set forth in Application Serial No. 86/063139, in that the mark is confusingly similar in appearance, sound and commercial impression to Opposer's NAKED Mark, thereby violating Opposer's common law rights in its trademark.

27. Registration of Applicant's NAKED UNDERNEATH Mark should not be granted as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its NAKED Mark.

WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 86/063139 for NAKED UNDERNEATH be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

Date: 4 November 2015

By: /michael leonard./
Michael J. Leonard
Gerard P. Norton
Christopher D. Olszyk, Jr.

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Lawrenceville, NJ 08648-2311
ipdocket@foxrothschild.com

*Attorneys for Opposer
Naked Brand Group Inc.*

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 4th day of November 2015 by sending same via First Class Mail, postage prepaid, to:

Badih Khamis
820 38th Avenue,
Lachine, Quebec H8T2C3
Canada

By: /michael leonard./